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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|---|-------------|----------------------|---------------------|-------------------|
| 10/787,130  | 02/27/2004  | Naoyuki Ezuka        | Q80148              | 4669              |
| 23373   | 7590        | 09/22/2006           | EXAMINER            |                   |
| SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      |                     | ALIMENTI, SUSAN C |
|   |             | ART UNIT             |                     | PAPER NUMBER      |
|   |             | 3644                 |                     |                   |

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/787,130             | EZUKA, NAOYUKI      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Susan C. Alimenti      | 3644                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 August 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) 5, 6 and 14 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 7-13, 15 and 16 is/are rejected.
- 7) Claim(s) 7 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 7 is objected to because of the following informalities: In line 7, the phrase “in as axial direction” appears to contain a typo. For reasons of examination, the word “as” will be considered to read --an-- until further clarification is given by applicant. Appropriate correction is required.
2. Claim 9 is objected to because the phrase “an dins” in line 5 appears to be a typo. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7, 8, 10, 11, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (US 6,105,302).

Yamamoto et al. ‘302 (Yamamoto ‘302) discloses a fishing rod, as best viewed in Figures 1, 2, and 11, comprising a rod pipe 1, a reinforced tubular body 2 made of a reinforced synthetic resin (col.3, lns.45-50), and a synthetic resin body 42, 43 which is integrally molded to an outside of the tubular member 2. The synthetic resin body is disclosed as optionally being made

of a synthetic resin (col.4, ln.37), or a foamed resin material (col.3, lns.63-64), both of which are softer than the reinforced pre-impregnated resin of the tubular member 2.

Regarding claim 8, the tubular body is inside member 42 of the resin body and is projected or extends in an axial direction of the tubular body.

Regarding claim 10, the tubular body 2 is made from a fiber reinforced plastic.

Regarding claim 11, member 41 is optionally made from a foamed material, artificial cork, or natural cork (col.3, lns.63-64).

Regarding claim 13, a reel mount is meant to fit inside portion 43 of the resin body (Figure 6).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (US 5,048,223).

Yamamoto et al. (Yamamoto '233) discloses a fishing rod comprising a rod pipe 11 that is inserted into a reinforced tubular body 12, and a synthetic resin body 13, 14 (col.4, lns.41-48) that is integrally molded with an outer side of the tubular body 12, at portion 12e. Integrally

molded body 13, 14 is made of a soft material, i.e. cork, or foam resin, since it serves the user as a grip portion and should be relatively soft compared to the rest of the rod in order to provide comfort to the user. While Yamamoto does not positively disclose what type of synthetic resin the tubular body 12 is made from, it must be rigid and durable enough to support the rod pipe 11 when the device is being used. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make tubular body 12 of a material that is harder than that of foam resin body 13, 14 in order to make it durable and strong for the purposes of the invention, i.e. fishing, since it has been held that there is no invention in the mere selection of a material that is known in the art for its suitability, for the intended purpose. *In re Leshin*, 125 USPQ 416.

7. Claims 1,4, 9, 12, and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Yamamoto '223 in view of Wallace.

Yamamoto '223 discloses a fishing reel comprising a rod pipe 11 that is inserted and fitted into a reinforced tubular body 12, and a synthetic resin body 13, 14 (col.4, lns.41-48) that is integrally molded with an outer side of the tubular body 12, at portion 12e, 12d. A concealing film (bonding agent, Yamamoto '223, col.4, ll.30-33) is formed in recess 12e, for sealing the connection between tubular body 12 to synthetic resin body 13. The outer portion of body 13 is considered to be a grip portion.

Regarding claim 4, opening 12a is ready to receive a leg of a reel.

Regarding the transparent characteristic of the synthetic resin body, Yamamoto '223 does not positively disclosed whether the construction materials used are colored, opaque, transparent,

translucent, etc. Wallace discloses a fishing rod having a handle that he teaches may be made of colored or transparent material for decorative purposes (Wallace, col.1, lns.59-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a transparent or translucent material as an obvious design choice in creating a preferred aesthetic appearance.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto '233 in view of Wallace as applied to claim 1 above, and further in view of Yamamoto '302.

Yamamoto, as modified, discloses the claimed invention except it is not positively disclosed that the tubular body is formed of a fiber reinforce prepeg material. Yamamoto '302 teaches the use of such a material, as it is an extremely strong material and will hold up against the forces encountered while sport fishing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a reinforced prepeg material in order to provide a strong and dependable material, since it has been held that there is no invention in the mere selection of a material that is known in the art for its suitability for the intended purpose. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, portion 12d of synthetic body 12 is considered to be a cover portion.

***Response to Arguments***

9. Applicant's arguments filed 24 August 2004 have been fully considered but they are not persuasive.

First regarding the previous 112(2<sup>nd</sup> par.) rejection of claim 1, it is noted that the examiner found the phrase “the tubular transparent synthetic resin body is fixed *to through* the concealing film” (emphasis added) indefinite. This phrase contained awkward grammar, and further was it was unclear that the resin body was “fixed to the gripped portion ‘through the concealing film’” as applicant has clarified in his recent remarks (Remarks submitted 8/24/06, p.6, par.3). The present amendment to claim 1 appears to overcome such indefiniteness.

Second, regarding the limitation “integrally molded,” applicant asserts that the present invention contains a “one-piece” structure where the synthetic resin body is integrally molded to the reinforced tubular body. Applicant continues in arguing that the prior art, i.e. Yamamoto ‘223 & ‘302, fails to disclose such a structure, and in contrast to the present invention said prior art comprises “individual” or “separate” elements that are not “integrally molded” to one another (Remarks submitted 8/24/06, p.7, par.3). Regarding Yamamoto ‘223, the examiner fails to see how the relationship between synthetic resin body 13, as it is molded to tubular body 12 to create a one-piece rod grip, is distinct from the relationship between tubular body 17 and molded synthetic resin body 16 in the present invention. A similar structure is taught in Yamamoto ‘302, where synthetic resin body 42 is molded to conform to tubular body 2 (Figure 1 & 2). Elements 17 and 16 of the present invention can also be said to be “individual” and “separate” elements that are simply molded to conform to one another. The examiner maintains that both Yamamoto

references disclose the integrally molded relationship that is disclosed and claimed in the present invention.

Regarding the 35 USC 103(a) rejection of Yamamoto '302 and the concealing film, the examiner has withdrawn this rejection, as presently amended claim 1 is no longer indefinite and can be properly ascertained. Regarding the subject matter of the concealing film and cover member, a 35 USC 103(a) rejection as obvious over Yamamoto '233 has now been set forth above.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 571-272-6897. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan C. Alimenti



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